

Remarks/Arguments

In the Office Action mailed December 18, 2003, the Examiner rejected claims 1-52 under 35 U.S.C. §102(b) over EP A 0 541 181 to Steeghs, et al

In response to the rejections applicants provide the following distinguishing remarks that are believed to place the present case in condition for allowance. Favorable reconsideration of all the pending claims is respectfully requested.

Initially, applicants wish to bring the examiner's attention to the fact that claims 53-60 were added in the Second Preliminary Amendment filed on August 2, 2002 (and received by the USPTO on August 8, 2002). These claims do not appear to have been addressed and/or rejected by the examiner. This point does, however, appear to be moot as applicants have canceled claims 53-60 in the present amendment.

Claims 1-4, 7,8,17, 24-27, 30-33, 40, 41, 44, 47, 51 and 52 are currently pending in this case. Support for the claim amendments can be found in the canceled claims and at numerous locations in the present specification.

Claim amendments have been made in order to more clearly define the type of ore, i.e., hematite ore that is agglomerated with the process of the invention. As will also become apparent in the arguments given below, two types of hematite ores exist, one which is easy to bind and one which is difficult to bind. The difficult to bind hematite ores comprise interfering elements which interfere with the binder's ability to effectively bind the ore. These interfering elements are not present in hematite ores that are not difficult to bind. Examples of difficult to bind and non-difficult to bind hematite ores are given in Table 7 on page 19 of the

present application. The non-difficult to bind hematite ores can also be agglomerated using binder systems without the chelating agent.

The only rejection of record is the rejection of the pending claims under **35 U.S.C. §102(b)** over EP A 0 541 181 to Steeghs, et al. EP A 0 541 181 (EP'181) is commonly owned by the assignee of the present application. Accordingly, applicants are intimately familiar with the technology disclosed therein. The Examiner should also note that the U.S. counterpart for EP'181 has issued as U.S. Patent No. 6,497,746.

To anticipate a claim under §102(b), a **single source must contain all of the elements of the claim**. Additionally, to constitute an anticipatory reference, the prior art must contain an **enabling disclosure for the claimed invention**.

EP'181 generally relates to a process for agglomerating particulate material and to products made from said process. Applicants respectfully submit that EP'181 **clearly fails to disclose or provide an enabling disclosure** for the claimed method for agglomerating "difficult to bind hematite ore comprising interfering elements". In fact, while EP'181 generically covers metallic ores, it fails to specifically mention individual types of ore, including hematite ores. Accordingly, applicants submit that EP'181 cannot be reasonably interpreted as anticipating the claimed invention under 35 U.S.C. §102(b).

At page 2 of the Action the examiner also relies on inherency as a basis for rejection. It is well known that inherent anticipation arises when the prior art necessarily functions in accordance with, or includes, the claimed limitations, regardless of whether persons of ordinary skill in the art would recognize the inherent characteristics or functioning of the prior art. The Federal Circuit explained the standard for determining inherency as follows:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Continental Can Co. USA, Inc. v. Monsanto Co. 20 U.S.P.Q.2d 1748, 1749 (Fed. Cir. 1991) (quoting *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

In the present situation EP'181 fails to identify individual metallic ores, let alone difficult to bind hematite ores comprising interfering elements. Further, EP'181 discloses a multitude of polymer binders and acids/salts of weak acids that can be employed therewith for general agglomeration. Given the **complexity** of the technology, the **numerous variables/permeations/possibilities** disclosed by EP'181 and the nature of the **very specific problem** to which the claimed invention is directed, applicants respectfully submit that "natural result" flowing from the general operation as taught by EP'181, as a whole, does not inherently anticipate the claimed invention. In other words, EP'181 is generally directed to agglomerating metal containing ores and does not recognize or appreciate the specific problem to which applicants' invention is directed. Given the numerous variables of EP'181, and the **probabilities and possibilities** associated therewith, applicants respectfully submit that EP'181 cannot reasonably be interpreted as inherently anticipating the claimed invention.

In view of the foregoing the subject rejection is believed to be improper; reconsideration and withdrawal thereof is respectfully requested.

In view of the amendments and remarks herein, all of the pending claims are believed to be in condition for allowance, which action is respectfully solicited.

Respectfully submitted,



Ralph J. Mancini
Attorney for Applicants
Registration No. 34,054

Akzo Nobel Inc.
Intellectual Property Dept.
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408
(914) 674-5465